

**REMARKS**

This amendment is presented in response to the office action ("office action") mailed March 7, 2006.

**35 USC 102 REJECTIONS: CLAIMS 34-61**

These claims were rejected under 35 USC 102(b) as being unpatentable over U.S. Patent No. 5,999,932 to Paul. The applied art does not teach the features of the claims (as amended). Taking claim 34 as an example, Paul fails to teach the following combination:

"A computer implemented method of operating a subscription manager to manage incoming machine readable messages arriving at a communications network having multiple remote user recipients, the method comprising the operations of:

independent of whether incoming messages have originated from a message originator pre-approved by the messages' addressees, the subscription manager determining if incoming messages are subscription type messages, subscription type messages comprising recurring messages multicast to a plurality of addressees who have previously communicated to originators of the messages their intent to receive such messages;

responsive to finding that a given message is a subscription type message, the given message having at least one addressee, performing operations comprising:

determining whether the given message originated from a subscription source pre-approved by the given message's addressee for sending subscribed-to messages to the addressee;

if the given message originated from a subscription source  
pre-approved by the given message's addressee,  
forwarding the given message to the addressee;  
if the given message did not originate from a subscription  
source pre-approved by the given message's  
addressee, blocking delivery of the given message to  
the addressee."

Considering some further aspects of claim 34, Paul fails to disclose "independent of whether incoming messages have originated from a message originator pre-approved by the messages' addressees, the subscription manager determining if incoming messages are subscription type messages, subscription type messages comprising recurring messages multicast to a plurality of addressees who have previously communicated to originators of the messages their intent to receive such messages." In contrast, Paul simply acts according to a user "inclusion" list (or a user "exclusion" list) to filter email according to whether it is desired by the user. [Paul: Abstract; col. 9, lines 55-68] Paul does not care whether messages are subscription type messages, i.e., recurring messages multicast to a plurality of addressees who have previously communicated to originators of the messages their intent to receive such messages. Rather, Paul is focused at filtering user unsolicited (junk) email, and this is the opposite of user solicited (subscription type) messages. [Paul: col. 1, lines 23-43; col. 1, line 66 – col. 2, line 63] Therefore, Paul does not care about the isolated fact of whether a message is a subscription type message. In contrast, Paul only cares about whether data from the incoming message matches the user's pre-approved list. [Paul: Abstract]

Claims 35 and 49 are further defined over Paul because Paul does not teach "responsive to determining that a given message is not a subscription type message, forwarding the given message to its addressee." First, as discussed above, Paul does not care whether a given message is a subscription type message or not. Second, Paul does forward a given message to its address on

the basis that the message is not a subscription type message. Accordingly, claims 35/49 are *a fortiori* distinguished from Paul.

Claims 37 and 51 are further defined over Paul because Paul does not teach "presenting to the given message's addressee an offer of a subscription to a machine-automated service of providing messages related to the given message, and only upon receiving acceptance of the offer, performing operations of: forwarding the given message to the addressee; precompleting a subscription activation form and providing the precompleted form to the addressee; responsive to the addressee's acceptance of the form, on behalf of the addressee obtaining from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message."

The office action suggests that such features can be found in Paul's column 6, lines 20-40. [Office Action: page 4] The cited passage, however, merely discusses Paul's addition of new data to the user inclusion list as incoming email is processed. For example, if an email's subject field matches the "subject" field in the user's inclusion list, then Paul automatically adds the "from" and "to" data from the email into the user's inclusion list.

In contrast, Paul has nothing to do with users' subscribing to electronically generated messages. Paul concerns the opposite, namely, processing incoming messages to filter unsolicited email. [Paul: Abstract; col. 1, line 66 – col. 2, line 63] Thus, Paul is devoid of operations such as "precompleting a subscription activation form and providing the precompleted form to the addressee" and "responsive to the addressee's acceptance of the form, on behalf of the addressee obtaining from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message." Clearly, Paul does not communicate with the source of a given message to obtain a subscription to messages. Rather, Paul's focus is on junk email, which is unsolicited. [Paul: column 1, lines 23-43] Accordingly, claims 37 and 51 are patentably distinguished from Paul.

Claims 38 and 52 are further defined over Paul because Paul does not teach "the subscription manager is operated remotely by a communications service provider on behalf of the user recipients; the operation of blocking delivery of the given message further comprises, only if the given message includes evidence that the given message originated from a recognized business partner of the service provider, presenting the addressee with at least one of the following user-activated options: (1) to receive the message, (2) to obtain from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message."

In one embodiment of Paul purportedly, filtering is purportedly performed at a central location for all users within a network such as a LAN. [Paul: col. 6, line 67 – col. 7, line 14] Nevertheless, Paul does not teach a subscription manager operated by a service provider on behalf of multiple user recipients, and a recognized business partner of the first entity. Accordingly, Paul is not concerned with whether a given message "originated from a recognized business partner of the service provider..." as claimed. Rather, Paul's sole criteria for filtering incoming emails is a user inclusion (or exclusion) list. Accordingly, claims 38 and 52 are *a fortiori* distinguished from Paul.

Claims 39 and 53 are defined over Paul for similar reasons, and in addition, because Paul does not teach the claimed operations where: "subscription manager is operated remotely by a communications service provider on behalf of the user recipients; the operations further comprise, apart from messages directed to the user recipients, the service provider receiving from recognized business affiliates of the service provider indicia identifying subscription type messages originating from said business affiliates; the operation of determining if incoming messages are subscription type messages comprises examining incoming messages for said indicia.

In contrast, Paul does not teach a subscription manager operated by a communications service provider having recognized business affiliates. In this regard, Paul is devoid of any discussion of business partners, affiliates, associates, etc. Moreover, Paul does not show a subscription manager receiving

(apart from messages directed to the user recipients) indicia from recognized business affiliates identifying subscription type messages originating from those affiliates. In contrast, Paul's sole criteria for filtering incoming emails is a user inclusion (or exclusion) list as discussed above. In this regard, Paul's system can be implemented on a user terminal system with a user interface such as MICROSOFT OUTLOOK. [Paul: column 3, lines 36-54] Paul is therefore unconcerned with any service provider, and further lacks any teaching regarding business affiliates of the service provider, and still further lacks an operation where the service provider receives information directly from business affiliates that is used to process incoming messages.

Accordingly, Claims 39 and 53 are patentably distinguished on their own merits, beyond the fact that they are patentable due to dependence on allowable base claims 34 and 48. Claims 40 and 54 are further defined over Paul for analogous reasons.

Claims 42 and 56 are further defined over Paul because Paul does not teach "the operation of, if the given message originated from a subscription source pre-approved by the given message's addressee, forwarding the given message to the addressee further comprises: determining which of the following that the given message pertains to: subscription maintenance or subscription content; making a different presentation of the given message to the addressee depending on whether the message pertains to subscription content or subscription maintenance."

The office action suggested that such features are found in Paul's column 6, lines 20-40. [Office Action: page 6] However, as discussed above, this passage merely discusses Paul's addition of new data to the user inclusion list as incoming email is processed. Since Paul does not address subscription type messages at all, Paul clearly fails to distinguish between "subscription maintenance" and "subscription content" as required by the claims. Further, Paul does not show "making a different presentation of the given message to the addressee" on such basis. Accordingly, claims 42 and 56 are patentably distinguished from Paul.

Claims 43-44 and 57-58 are distinguished over Paul for similar reasons as claims 42/56, and additionally because Paul does not teach any communications with the sources of received messages. Rather, Paul's approach is simply to filter incoming messages. [Paul: Title; Abstract] In all cases, Paul's disclosure necessarily teaches away from communicating with the source of received messages. It is widely known that communicating with a junk email sender (such as by indicating a request to stop the junk email) is ineffective, and worse yet, may result in validation of the recipient's email address to the junk email sender, causing a proliferation of junk email. Therefore, Paul teaches away from any communications with the sources of unsolicited email messages..

Relatedly, in the case of claims 43/57, Paul further lacks a user-activated cancellation message. Nor does Paul teach the negotiation of subscription cancellation with the subscription source free of further input by the given message's addressee. In the case of claims 44/58, Paul further fails to teach negotiating activation of the subscription with the subscription source. Accordingly, claims 43-44 and 57-58 are patentably distinguished over Paul on their own merits, beyond their allowability by virtue of their dependence on allowable base claims 34 and 48.

#### NEW CLAIM

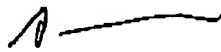
Claim 62 has been added to the application. This claim is patentably distinguished from Paul for similar reasons as discussed above, along with further reasons particular to the specific language of this claim. No new matter has been added, since the new claim enjoys widespread support in the originally-filed specification, for example, pages 7 & 13-15, Figure 5, Figure 6, Figure 8, etc.

#### CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art. Favorable reconsideration and allowance of the application are hereby requested.

If any fees are required by this submission, an appropriate fee submittal sheet is enclosed herewith. If fees are required yet this sheet is inadvertently missing, or the fees are incorrect in amount, please charge the charge the required fees (or credit any overpayment) to Deposit Account No. 07-1445.

Respectfully Submitted,



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